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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

MCT.0005D1US

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on September 28, 2005

Signature

Typed or printed name

Cynthia L. Hayden

Application Number

09/496,794

Filed

February 2, 2000

First Named Inventor

John T. Moore et al.

Art Unit

2811

Examiner

Douglas W. Owens

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. 28,994
Registration number _____

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Timothy N. Trop

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Telephone number

September 28, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John T. Moore et al. § Group Art Unit: 2811
Serial No.: 09/496,794 §
Filed: February 2, 2000 § Examiner: Douglas W. Owens
For: Trench Isolation for § Atty. Dkt. No.: MCT.0005D1US
Semiconductor Devices § 97-0608.02US

Mail Stop AF
Commissioner for Patents
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Alexandria, VA 22313-1450

STATEMENT IN SUPPORT OF PRE-APPEAL REVIEW

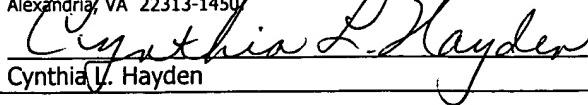
Sir:

Claim 26 calls for a first material deposited on a support, the first material having a first etch rate. A trench is formed through the first material into the support. The Examiner seems to suggest that this is some type of method limitation. It is not. It defines what the trench is. The trench is formed through the first material and into the support. The claim further calls for a trench filler material deposited in the trench. Therefore, since the trench is through the first material and the trench filler material is deposited in the trench, it is a logical impossibility for the first material and the trench material to be the same. Since the Examiner takes the exact opposite position, there is no possible way that the rejection could be correct. Therefore, pre-appeal review is sought.

In the Advisory Action, the Examiner makes the following statement that is so plainly impossible as to demonstrate the failure to establish a *prima facie* rejection:

Horie teaches a structure including material (6, 9) on the surface of the substrate. This material (9) could have been deposited on the surface, followed by etching a trench through the material (9) and into the substrate and then depositing a filler material (9) which is identical to the material deposited on the substrate.

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Cynthia L. Hayden


The problem is that there nothing in the reference which would suggest that the material (9) could have been deposited on the surface, followed by a re-deposition of the identical material (9). This being so, the asserted structure is impossible. In other words, it is improper for the Examiner to speculate as to some potential fabrication technique which is plainly inconsistent with what is shown in the reference. Moreover, as the Examiner points out, it is not the fabrication technique that is claimed, but the structure. There is no first material deposited on the support and a trench formed through that first material and then a trench material deposited in the trench. The claimed structure requires a trench extending through a first material and a second material, called a trench material, filled in the trench. There is no way under any reasonable reading of the claim that the trench filler material and the first material could be the same.

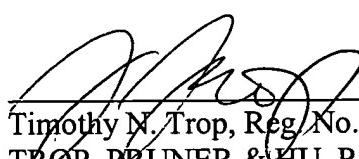
To the extent that the Examiner is now relying on some inherency property, even the Examiner's exposition makes it clear that he does not believe that the reference necessarily is formed in the claimed fashion. Therefore, there is no basis for such an inherency rejection.

It seems that part of the Examiner's issue is that he believes that the claim somehow defines methods when, in fact, it only defines structure. It defines a first material deposited on the support having a first etch rate. A trench formed through the first material and into the support. This does not define a method, it merely defines where the trench exists. The trench filler material is then in that trench. The trench cannot extend through the first material, be filled with the trench filler material, and the trench filler material and the first material be the exact same material. There are two reasons for this. One, the structural relationships make this impossible. Moreover, the claim requires that the trench filler material have an etch rate that is 1.2 times the first etch rate, the first etch rate being the etch rate of the first material. Therefore, they simply cannot be the same material.

Given the fact that it is impossible to apply the reference to the claim, the rejection should be withdrawn.

Respectfully submitted,

Date: September 28, 2005



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